

REMARKS

The Examiner is requested to reconsider the rejection of the claims 1 - 4, 6, 12, 14 - 19 under 35 U.S.C. §102(b) as being anticipated by Deo (U.S. Patent No. 5,721,781).

Applicants respectfully submit that the Deo patent cited above is not relevant with respect to the instant application.

With respect to the rejection of claim 1, Applicants emphasize that in the present invention, an important element defined in claim 1 is "... *comprising selective information concerning a user-desired type of operation....*" The Examiner is contending that this feature as an element would also be covered by Deo, column 3, lines 25-30, 41-44. Applicants respectfully submit that the Examiner is incorrect in his interpretation of Claim 1. Deo, merely describes the general use of a multi- purpose smart card.

In the present invention, there may be one or more applications on the smart card, but this is not relevant to nor an objective of the present invention. On the device-side (i.e., the device the card controls the access to), Applicants have one application, but depending on the information stored on the card, the system allows the user of the cards different options. This feature is now included in Claim 1.

Deo, column 3, lines 41-44 discloses different security levels, but in the Deo system as described, this is dependent on the terminal (i.e., in Applicants' terms "device"), not the smart card (as in the present invention). This feature is now also included in Claim 1.

Re: Claim 2. Applicants would agree with the position of the Examiner, if claim 2 were an independent claim, however as Claim 2 is dependant on claim 1, and Claim 1 is clearly distinguishable now from Claim 1, the rejection is without foundation.

Re Claim 3. It is respectfully submitted that the Examiner may be we confused by what the Deo reference is disclosing at the cited excerpt of the Deo reference. Deo is referring to expired certificates. For example, one cannot use a certificate which expires on June 30, 2004 on July 1st 2004 (and beyond). What Applicants are claiming is that the user, for example, has a time account which can use this device, for example, for 30 minutes each day as is described on page 11 of the specification. In Claim 3, Applicants are claiming a totally different feature from that described by Deo.

Re: Claim 4: Deo at Column 5, lines 3-4 is making a very general statement that "smart cards can be used to ... organize account information for routinely paid services such as cable TV." He is not explaining that which he is attempting to disclose with sufficient specificity that provides a understandable disclosure. One can only speculate what the application mentioned by Deo consists of. The cited excerpt is too vague and general to provide a proper anticipation of Claim 4 as presently written. Applicants system might be used to access cable TV. However Applicants have addressed a veryspecifica problem which is detailed in the specification and claims as not presented and have defined a very specific invention designed to solve a specific set of problems as also depicted in Figs.1 and 2.

Re: Claim 6, 16 19: As noted above in the comments on Claim 1, with regard to "security" as described in Deo, the data to decide about the "security level" is per terminal and is kept on the terminal. In the present invention the data is user-related data stored on the smart card and is carried around by the user. These are two totally different systems.

Re: Claim 7: In the present invention, Claim 7 defines the device, which is controlled by the smart card. By way of contrast, Deo, at Column 4, lines 51-57 is talking about the smart card per se. The are two totally different concepts and elements.

Re: Claim 8: Deo, merely describes a simple Yes/No access, whereas the present invention describes a detailed, fine grained access control system.

Re: Claim 9: The Examiner's rejection takes elements and systems out of context. Both invention do use Smart cards, but the elements defined in the claims distinguish the present invention over Deo.

Re: Claim 10: Claim 10 defines the software on the smart card, whereas Deo is referring to the software on the terminal/device. Again these are two totally different items.

Re: Claim 11: The Examiner has quoted Deo, Column 11 , lines 19- 25 and lines 45-49 as the bases for the rejection to Claim 11. Applicants hereby incorporate the response to Claims 3 and 6 set forth above in response to this rejection. In Deo, at Column 12, lines 24-26, Deo is referring to selecting the application on the smart card. The present invention is disclosing the level of access that a user gets for an application on the device (in Deo's terms, on the terminal).

Re: Claim 12: Applicants request a clarification on this rejection as they are not sure how Deo, Column 12, lines 39 - 41 relates to Claim 12.

The Examiner is respectfully requested to reconsider his rejection of Claims 5 and 20 under 35 U.S.C. 103(a) as being unpatentable obvious as obvious over United States Patent 5,721,781 Deo, et al. in view of United States Patent 6,647,270 to Himmelstein.

Re: Claims 5 and 20: As to Claim 5, in order to be a proper reference, the cited reference should disclose the art in such clear and concise terms so as to enable one skilled in the art to duplicate same and thereby understand what is disclosed. It is not apparent how Himmelstein, Column 4 , lines 4-10 functions or operates. The reference states: "This unique system regarding the vehicle may also include the position of the vehicle, speed of the vehicle and rate of acceleration of deceleration as calculated by data obtained from the GPS received". It is not clear what role, if any, the smart card plays here and to what usage it is put, if any. One can speculate that this data (as provided by the GPS system) is stored somewhere.

In the present invention, the smart card provides some limiting factors. For Example, the user can one go 55 MPH, or not drive from Maryland to Virginia, which is then compared to the data received from GPS and enforced. The Himmelstein system merely tells the driver where he is and apparently continuously computes the differential calculus associated with determining velocity, acceleration, and distance. The card, if that's what it is, does not control where the user is travelling as is the case in Applicants' invention.

Re: Claim 20: Applicants hereby incorporate the response to Claims 3 and 6 set forth above in response to this rejection.

Re: Claim 13: Gurantz is merely a Yes/No access control using smart cards for a set-top box, as everyone is acquainted with for an ATM. The present inventions describes a much more advanced system with much more fine-grained access mechanisms.

In order to analyze the propriety of the Examiner's rejections in this case, a review of the pertinent applicable law relating to 35 U.S.C. § 103(a) is warranted. The Examiner has applied the various references discussed above using selective combinations to render obvious the invention.

The Court of Appeals for the Federal Circuit has set guidelines governing such application of references. These guidelines are, as stated are found in Interconnect Planning Corp. v. Feil, 774 F.2d 1132, 1143, 227 USPQ, 543, 551:

When prior art references require selective combination by the court to render obvious a subsequent invention, there must be some reason for the combination other than hindsight gleaned from the invention itself.

A representative case relying upon this rule of law is Uniroyal, Inc. v. Rudkin-Wiley Corp., 837 F.2d 1044, 5 USPQ 2d 1434 (Fed. Cir. 1988). The district court in Uniroyal found that a combination of various features from a plurality of prior art references suggested the claimed

invention of the patent in suit. The Federal Circuit in its decision found that the district court did not show, however, that there was any teaching or suggestion in any of the references, or in the prior art as a whole, that would lead one with ordinary skill in the art to make the combination. The Federal Circuit opined:

Something in the prior art as a whole must suggest the desirability, and thus the obviousness, of making the combination. [837 F.2d at 1051, 5 USPQ 2d at 1438, citing Lindemann, 730 F.2d 1452, 221 USPQ 481, 488 (Fed. Cir. 1984).]

Applicants respectfully submit that there is no basis for the combination of the Deo et al. and Himmelstein, references cited by the Examiner. The references teach in different directions. The Examiner has selected elements and/or steps from disparate references for the sake of showing the individual elements and/or steps claimed, without regard to the total teaching of the references.

As noted, the Examiner is improperly picking and choosing. It is a piecemeal construction of the invention. Such piecemeal reconstruction of the prior art patents in light of the instant disclosure is contrary to the requirements of 35 U.S.C. § 103.

The ever present question in cases within the ambit of 35 U.S.C. § 103 is whether the subject matter as a whole would have been obvious to one of ordinary skill in the art following the teachings of the prior art at the time the invention was made. It is impermissible within the framework of Section 103 to pick and choose from any one reference only so much of it as will support a given position, to the exclusion of other parts necessary to the full appreciation of what such reference fairly suggests to one of ordinary skill in the art. (Emphasis in original) In re Wesslau 147 U.S.P.Q. 391, 393 (CCPA 1965)

This holding succinctly summarizes the Examiner's application of references in this case, because the Examiner did in fact pick and choose so much of the references to support his position and did not cover completely in the Office Action the full scope of what these reference disclosure fairly suggest to one skilled in the art.

Further, the Federal Circuit has stated that the Patent Office bears the burden of establishing obviousness. It held this burden can only be satisfied by showing some objective teaching in the prior art or that knowledge generally available to one of ordinary skill in the art would lead that individual to combine the relevant teachings of the reference.

Obviousness is tested by "what the combined teachings of the references would have suggested to those of ordinary skill in the art." In re Keller, 642 F.2d 413, 425, 208 USPQ 871, 881 (CCPA 1981). But it "cannot be established by combining the teachings of the prior art to produce the claimed invention, absent some teaching or suggestion supporting the combination." ACS Hosp. Sys., 732 F.2d at 1577, 221 USPQ at 933. [837 F.2d at 1075, 5 USPQ 2d at 1599.]

The court concluded its discussion of this issue by stating that teachings or references can be combined only if there is some suggestion or incentive to do so.

In the present case, the skilled artisan, viewing any or all of the references would be directed toward a totally different system than is called for in the present invention. For the reasons listed above in this response with respect to the Deo et al. and Himmelstein, references, there is no proper basis to combine them.

Applicants have attempted in this response to amend the claims to place the claims in a form which should result in their allowability. If the Examiner wishes to discuss via telephone the substance of any of the proposed claims contained herein with the intent of putting them into an allowable form, Applicants' attorney will be glad to speak with the Examiner at a mutually agreeable time and will cooperate in any way possible.

In view of the arguments and modifications to the claims, allowance of this case is warranted. Such favorable action is respectfully solicited.